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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/688,869 | 02/26/2004 | Rey Zabab Mendoza | | 7401 |

7590 07/13/2007
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| EXAMINER |
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GROSSO, HARRY A

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| ART UNIT | PAPER NUMBER |
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3781

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07/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/688,869 | Applicant(s) MENDOZA ET AL. | |
| | Examiner Harry A. Grosso | Art Unit 3781 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A telephone interview was conducted between the applicant, Rey Mendoza, and Examiner Eugene Lhymn on February 3, 2006. In that interview agreement was reached and applicant approved an Examiner's Amendment. However, the Examiner's Amendment was never issued and further action is required to place this application in condition for allowance. The actions agreed to previously and those still required are addressed in this Office Action which is non-final since it includes issues not addressed in the prior Office Action. A copy of the interview summary has been mailed to the applicant.

Assignee Consent

The reissue Patent Application Transmittal form for the application shows this patent is assigned (the "yes" box of item 7 of Form PTO/SB/50 is checked). However, the written consent indicates there is no assignment of the patent. If there is no assignment, a corrected Patent Application Transmittal form with the "no" box of item 7 checked needs to be filed.

The Consent of Assignee; Statement of Non-Assignment form (PTO/SB/53) filed on 10/20/2003 was signed only by Rey Zabat Mendoza. Another inventor, Wilhelmina Navarro Mendoza, also needs to sign a Consent of Assignee; Statement of Non-Assignment form.

Oath/Declaration

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. A new oath/declaration must be filed.

As a result of the agreement reached in the telephone interview of February 3, 2006, the statement of the error upon which the reissue is based is no longer valid. It is suggested that the last sentence of the first paragraph describing the error be changed to read, "The intent was to have at "three equal length parts joined together and joined to the frame by at least two hinges."

In the Reissue Declaration filed 2/3/2006, the box of "is attached hereto" should not have been checked, instead the box of "was filed on _____ as reissue application number _____" should have been checked with the filing date of October 20, 2003 and application number 10/688,869 written in the appropriate spaces.

Specification

The amendment filed October 20, 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Reference to a "sphere," "spherical shape" or "spherical shape (depending on the number of leg hinges 22 used)" has been added to the paragraphs beginning at column 1, line 20; column 1, line 64; column 2, line 26; column 2, line 53; column 3, line 3; and column 3, line 44. A new penultimate sentence has been added to the paragraph beginning at column 4, line

33, "The vertical leg members can each have more than two leg hinges, the numbers of which will determine the degree of spherical shape it has in the expanded state." The limitation of a sphere or spherical shape was not described in the original disclosure. The limitation of a "polygon-shaped ball" does not clearly include a limitation as "spherical," wherein a "polygon-shaped ball" is interpreted as having a plurality of discrete segments, thus not including a spherical shape, which is continuous.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the limitation "or spherical" was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, wherein the limitation "polygon-shaped ball" does not clearly include such a limitation as "spherical" wherein a "polygon-shaped ball" is interpreted as having a plurality of discrete segments, thus not including a spherical shape, which is continuous.

Reissue Applications

2. Claim 1 is rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. In the instant case, the omitted limitations "a third and two thirds" and "to 45-degree angles from the vertical" were originally surrendered by applicant to obviate Examiner Moy's rejection, thus resulting in improper recapture of surrendered subject matter.

Conclusion

Based on amendments agreed to in the interview of February 3, 2006, the examiner suggests applicant submit new amended specification paragraphs deleting the new matter as follows:

Paragraph beginning at column 1, line 20: delete "or have a spherical shape".

Paragraph beginning at column 1, line 64; delete "or spherical (depending on the number of leg hinges 22, used.)".

Paragraph beginning at column 2, line 26: delete "or spherical (depending on the number of leg hinges 22 used)".

Paragraph beginning at column 2, line 53: delete "or sphere".

Paragraph beginning at column 3, line 3: delete "or spherical shape (depending on the number of leg hinges 22 used)".

Paragraph beginning at column 3, line 44: delete "or sphere".

Paragraph beginning at column 3, line 44: delete "or spherical".

Paragraph beginning at column 4, line 33, delete the new penultimate sentence reading "The vertical leg members can each have more than two leg hinges, the numbers of which will determine the degree of spherical shape it has in the expanded state."

With regards to claim 1, the examiner recommends that a new amended claim be filed starting with claim 1 of current Patent 6,481,591 and amending it as follows:

In line 56 insert "length" between "equal" and "parts".

In line 57 insert "at least two" before "hinges".

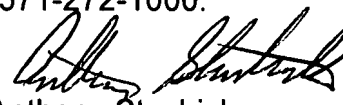
In line 57 insert "equidistant" before "points".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony Stashick
Supervisory Patent Examiner
Art Unit 3781

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